Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKAHIRO KATOH

Appeal No. 97-2546
Application 08/399,722[1]

HEARD: March 8, 1999

Before FRANKFORT, PATE, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 3, 5, 7 through 14 and 25 through 35 as amended subsequent to the final rejection in papers filed June 27, 1996 (Paper No. 10), August 1, 1996 (Paper No. 12) and

[1] Application for patent filed March 7, 1995.

February 7, 1997 (Paper No. 17). The above enumerated claims are all of the claims recognized by appellant and the examiner as remaining in the application, claims 1, 2, 4, 6 and 15 through 24 having purportedly been canceled.[2]

Appellant's invention is directed to a watertight grommet. Independent claims 34 and 35 are representative of the subject matter on appeal and a copy of those claims may be found in Paper No. 17, filed February 7, 1997.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Ono et al. (Ono)	4,797,513	Jan. 10, 1989
Oikawa et al. (Oikawa)	4,928,349	May 29, 1990
Takayanagi et al. (Takayanagi) (Japanese) (Translation attached)	6-150,757	May 31, 1994

[2] While both the examiner and appellant seem to be in agreement that claim 22 has been canceled, our review of the record reveals no formal amendment which has actually requested cancellation of claim 22. However, since the rejections before us on pages 4 and 5 of the answer have not treated claim 22, we leave it to appellant and the examiner to clarify the status of this claim during any further prosecution of the application before the examiner. We also observe that the amendment filed August 1, 1996 has not yet been fully entered. Note particularly, page 4 of that amendment.

Claims 3, 5, 7, 9 through 12, 14, 25, 26 and 28 through 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takayanagi.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Takayanagi in view of Oikawa.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Takayanagi in view of Ono.[3]

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 16, mailed

[3] The examiner's rejection of claims 3, 5, 7 through 14 and 25 through 35 under 35 U.S.C. § 112, second paragraph, made as a new ground of rejection on page 5 of the examiner's answer, has now been withdrawn by the examiner in light of the amendment filed by appellant on February 7, 1997 (See the examiner's letter mailed April 30, 1997). With the withdrawal of this rejection, we note that there is currently no pending rejection of dependent claim 27 on appeal. However, since this belatedly added claim includes the same limitations as claim 8 on appeal (which was rejected) and depends from the broader independent claim 35, we consider that it was merely an oversight on the examiner's part that this claim was not also rejected under 35 U.S.C. § 103 based on Takayanagi in view of Oikawa, as was claim 8.

December 23, 1996) for the examiner's reasoning in support of the rejections, and to appellant’s brief (filed November 13, 1996) for appellant’s arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant’s specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first to the examiner’s rejection of claims 3, 5, 7, 9 through 12, 14, 25, 26 and 28 through 35 under 35 U.S.C. § 102(b) as being anticipated by Takayanagi, we note that the relevant portion of this section of the statute indicates that a person shall be entitled to a patent unless ---

> (b) the invention was patented or described in a printed publication in this or a foreign country... more than one year prior to the date of the application for patent in the United States.

The publication date of the Takayanagi reference applied by the examiner is May 31, 1994. Appellant's filing date in the United States for the present application is March 7, 1995. Accordingly, it is clear on its face that Takayanagi is not a valid reference under 35 U.S.C. § 102(b), since it was not published "more than one year prior to the date of the application for patent in the United States." However, given the clear nature of this oversight made both on the part of the examiner and appellant, we consider it fair to both sides in this appeal to merely treat this rejection as being properly made under 35 U.S.C. § 102(a).

Looking first to independent claim 34, we share appellant's view (brief, page 6) that Takayanagi fails to teach or show a watertight grommet including a core and sleeve combination having at least one annular protuberance thereon and at least one annular groove complementary to the protuberance as required in this claim. While it is clear

from Figures 1 and 4 that the core member (10) of Takayanagi includes an annular positioning protuberance (17) thereon for abutting against the end wall (18) of the sleeve part (4) when the core and sleeve are assembled together, we see no annular groove on the sleeve which is complementary to said protuberance.

The examiner's position (answer, page 6) that the element (8) shown in Figure 1 of Takayanagi is part of the sleeve and "has an annular groove which is complementary to the annular protuberance 17," in our opinion, is based on total speculation and conjecture. Even if we were to agree with the examiner that the fixing tape (8) wrapped about the sleeve part (4) and the adjacent portion of the core (10) at the right side of Figure 1 of Takayanagi could be considered to be part of the sleeve, there is no reasonable basis to conclude that the inner surface of the "sleeve" (tape 8) necessarily includes an annular groove that is complementary to the protuberance (17) on the core (10). The wrapping of the tape (8) in the vicinity of the protuberance (17) could just as easily bridge the space from the edge (at wall 18) of the

sleeve part (4) onto the core (10) without contacting the relatively small protuberance (17) at all, and clearly could be accomplished without forming an annular groove that is complementary to the protuberance (17). For this reason the examiner's rejection of independent claim 34 under 35 U.S.C. § 102 based on Takayanagi will not be sustained.

It follows from the foregoing that the § 102 rejection of claims 3, 5, 7, 9 through 12 and 14 which depend from claim 34 will likewise not be sustained. As for claims 8 and 13, which also depend from claim 34, we have reviewed the references to Oikawa and Ono applied by the examiner under 35 U.S.C. § 103, however, we find nothing in these references which provides for that which we have indicated above to be lacking in Takayanagi. Accordingly, the examiner's rejections of claims 8 and 13 under 35 U.S.C. § 103 will also not be sustained.

Independent claim 35 differs from claim 34 in that it does not include the recitations concerning the annular protuberance and complementary annular groove. Thus, appellant's arguments concerning such elements of the

disclosed invention have no merit with regard to independent claim 35. Absent any persuasive argument from appellant which demonstrates error on the examiner's part with regard to the rejection of independent claim 35, we are constrained to sustain the examiner's rejection of that claim under 35 U.S.C. § 102 based on Takayanagi. Moreover, given appellant's indication on page 5 of the brief that the claims "stand or fall together," we note that claims 25 through 33, which depend from independent claim 35, are considered to fall with claim 35.

In summary, the decision of the examiner rejecting claims 3, 5, 7, 9 through 12, 14 and 34 under 35 U.S.C. § 102 as being anticipated by Takayanagi is reversed, as is the examiner's decision rejecting claims 8 and 13 under 35 U.S.C. § 103 based on Takayanagi and Oikawa or Ono. However, the examiner's decision rejecting claims 25 through 33 and 35 is sustained.

No time period for taking subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES E. FRANKFORT Administrative Patent Judge	)
WILLIAM F. PATE, III Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)

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